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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,291	11/13/2001	Kram Henry Allen	10015384-1	3859

7590 08/02/2006
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EXAMINER

LIN, KELVIN Y

ART UNIT PAPER NUMBER

2142

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,291

Applicant(s)

ALLEN ET AL.

Examiner

Kelvin Lin

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

Responds to Arguments

1. The Applicant's argument with respect to claims 1-22 have been considered but they are not persuasive.
2. Applicant is arguing:
 - 1) Tafoya fails to teach or suggest "selectively displaying a list of most recently used email addresses and/or most frequently used email addresses based on said signal in response to user input from a mouse input device configured for clicking on a software button and not in response to a user typing characters into an addressing field " as required by claim 1, 9, 17, 18, and 22.

As point 1), where the applicant argues that Tafoya fails to teach or suggest "... input from a mouse input device configured for clicking on a software button and not in response to a user typing characters into an addressing field", it has been considered but is not persuasive. Tafoya does teach that at col. 13, l.17-29 and fig. 5, the address/contact resolution pop-up 520 also preferably provides an option via a "push-button" or the equivalent for the user to select the desired entry 540 from the resolution list for addressing the email with auto-completion information. Moreover, because entries are displayed from highest to

lowest weight 530, the user may browse the contents of the resolution list. As Applicant mentioned that "Tafoya et al explicitly states that ... as a user types characters into an addressing field 612, a pop-up menu 610 appears directly below the cursor 614 as shown in Fig. 6". This is one of more features in the Tafoya's invention that provides users more options to select and it is not a "teaching away". Because, both features can be performed independently.

Response to Amended Claims

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language:

4. Claims 1-22 are rejected under 35 USC 102(e) as being anticipated by Tafoya et al., (US Patent No. 6829607).
5. Regarding claim 1, Tafoya teaches a system for facilitating email

communications comprising:

- first means for monitoring when emails are sent and/or how often the emails are sent to different email addresses and providing a signal in response thereto (Tafoya, col.2, l.24-25, l.32-33, l. 38-40, in that the interface is the signal in response) and
- second means for selectively displaying a list of most recently used email addresses and/or most frequently used email addresses based on said signal in response to user input from a mouse input device configured for clicking on a software button and not in response to a user to a user typing characters into an addressing field; (Tafoya,col.2, l.49-51, col.4, l.57-61, col. 13, l.17-29, fig. 5) ; and
- user configurable options to allow user selection of a length of the list, user sorting of the list by recency and/or frequency, and user inclusion of received email addresses in addition to or instead of sent email addresses in the list (Tafoya, Abstract, col.2, l.57-67, col.4, l.57-67, col.5, l.4-8, clo.7, l.9-20, col.9, l.1-7).

6. Regarding claim 2, Tafoya further discloses the system of claim 1 wherein said first means includes email address usage-tracking software in communication with email communications software (Tafoya, col.4, l.34-39).
7. Regarding claim 3, Tafoya further discloses the system of claim 2 wherein said

second means includes email address sorting software in communication with said email address usage-tracking software, said email address sorting software employing a data structure containing priorities associated with a predetermined number of email addresses (Tafoya, col.4, l.57-58).

8. Regarding claim 4, Tafoya further discloses the system of claim 3 wherein said predetermined number of email addresses and methods for assigning priorities to said email addresses are user-configurable via a user-interface to said email address sorting software (Tafoya, col.11, l.46-50).
9. Regarding claim 5, Tafoya further discloses the system of claim 4 wherein said data structure is implemented as an email address book designed to allow said email address sorting software to sort email addresses in said address book according to priority values assigned to each email based on user-input to said email address sorter and based on said signal (Tafoya, col.11, l.66-67, col.12, l.1-3).
10. Regarding claim 6, Tafoya further discloses the system of claim 5 wherein said second means includes means for displaying a sorted drop-down list or menu of email addresses selected from said email address book and sorted according to said priority values (Tafoya, col.12, l.66-67, col.13, l.46-49).
11. Regarding claim 7, Tafoya further discloses the system of claim 4 wherein said data structure is implemented as a priority queue (Tafoya, col.4, l.57-58).
12. Regarding claim 8, Tafoya further discloses the system of claim 7 wherein said email address sorting software includes means for selectively incrementing a

priority value assigned to a given email address when an email is sent to said given email address, and includes means for selectively deleting email address priority values from said priority queue to limit the size of said data structure to predetermined maximum size (Tafoya, col.11, l.16-22, l.42-45, col.12, l.20-30).

13. Regarding claim 9, Tafoya further discloses a system for facilitating email communications comprising:

- first means for sending an email and providing a signal in response thereto when said email is sent to a recipient associated with a predetermined email address (Tafoya, col.4, l.57-60, col.9, l.66-67);
- second means for assigning a priority to said email address based on said signal and predetermined configuration information (Tafoya, col.4, l.57-58, col.10, l.8-11);
- third means for sorting said email address in a list of email addresses according to said priority (Tafoya, col.10, l.12-23); and
- fourth means for displaying said list of email addresses in response to a user using a mouse input device to click on a software button and not in response to a user typing characters into an addressing field (Tafoya, col.13, l.17-29, l.46-49, fig. 5) ; and
- user configurable options to allow user selection of a length of the list, user sorting of the list by recency and/or frequency, and user inclusion of received email addresses in addition to or instead of

sent email addresses in the list (Tafoya, Abstract, col.2, l.57-67, col.4, l.57-67, col.5, l.4-8, clo.7, l.9-20, col.9, l.1-7).

14. Regarding claim 10, Tafoya further discloses the system of claim 9 wherein said first means includes an email software application running on a computer (Tafoya, col.6, l.4-21).
15. Regarding claim 11, Tafoya further discloses the system of claim 10 wherein said second means includes a user interface in communication with a user-input device and said email software package for providing user-configurable options for specifying said configuration information to determine said priority based on said signal (Tafoya, col.11, l.46-50).
16. Regarding claim 12, Tafoya further discloses the system of claim 11 wherein said user-configurable options include frequency and recency options, which when selected, assign higher priorities to more frequently used email addresses or more recently used addresses, respectively (Tafoya, col.11, l.66-67, col.12, l.1-3, l.48-50).
17. Regarding claim 13, Tafoya further discloses the system of claim 11 wherein said configurable options include a list size option, a maximum value of said priority, and/or an amount by which to increment or decrement said priority of each email address in said list via said second means in response to said signal (Tafoya, col.10, l.16-22, l.42-45, col.12, l.20-30).
18. Regarding claim 14, Tafoya further discloses the system of claim 13 wherein said third means includes means for sorting said list in order of decreasing priority as

- indicated by said priority value (Tafoya, col.10, l.30-31).
19. Regarding claim 15, Tafoya further discloses the system of claim 14 wherein said third means includes a user-configurable email address sorter (Tafoya, col.10, l.30-31).
 20. Regarding claim 16, Tafoya further discloses the system of claim 14 wherein said fourth means includes a drop-down list or a menu in communication with said third means. (Tafoya, col.13, l.46-49).
 21. Regarding claim method 17, has limitations corresponding to system claims 1-5. Therefore, claim 17 is rejected for the same reasons set forth in the rejection of claims 1-5.
 22. Regarding claim 18-21, claiming for software package, has limitations corresponding to system claims 9-15, except sending in parallel to plural email, which also disclosed at (Tafoya, col.7, l.45-47). Therefore, claim 18 is rejected for the same reasons set forth in the rejection of claims 9-15.
 23. Regarding method claim 22 has limitations corresponding to system claim 1, Therefore, claim 22 is rejected for the same reasons set forth in the rejection of claim 1.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first replay is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE MONTH** shortened statutory period, then the shortened statutory period will expire on the date advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTH** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Lin whose telephone number is 571-272-3898. The examiner can normally be reached on Flexible 4/9/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KYL

7/28/06

A handwritten signature in black ink, appearing to read "Andrew Caldwell". The signature is fluid and cursive, with a long horizontal stroke at the end.

ANDREW CALDWELL
PATENT EXAMINER